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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/587,058 06/02/00 SCHIERLING

B 4452-195RE

EXAMINER

PM82/1025

THOMAS C PONTANI ESQ
COHEN PONTANI LIEBERMAN & PAVANE
551 FIFTH AVE SUITE 1210
NEW YORK NY 10176

BONCK, R

ART UNIT

PAPER NUMBER

3681

DATE MAILED:

10/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/587,058

Applicant(s)

Bernhard Schierling

Examiner

Rodney H. Bonck

Group Art Unit

3681



☒ Responsive to communication(s) filed on Jun 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-4 is/are allowed.

☒ Claim(s) 5-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/625,759.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

The following is a first action on the merits of application Serial No. 09/587,058, filed June 2, 2000, which is a reissue of application Serial No. 08/625,759, filed March 29, 1996.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/625,759, filed on March 29, 1996.

Information Disclosure Statement

Receipt is acknowledged of the Information Disclosure Statement filed June 2, 2000. The cited documents have been considered.

Drawings

The drawings as filed have been approved by the Draftsperson.

Reissue Applications

The specification is objected to because it fails to include changes, additions, or deletions that were made by Certificate of Correction in the original patent. See MPEP 1411.01. These

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changes should be added to the specification without underlining and bracketing because they are part of the original patent and were made before the reissue was filed.

Appropriate correction is required.

Claim 8 is objected to because it does not end in with a period. See MPEP 608.01(m).

Appropriate correction is required.

Claims 5-8 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The record of the application for the patent shows that recitation that the insulating member comprises a metal portion and an additional portion was deemed to distinguish the claims over the prior art (see the supplemental final rejection, Paper No. 12, applicant's "REMARKS" of Paper No. 16, and the Reasons for Allowance, Paper No. 18). Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 5, 6, and 8 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Hays('704). With respect to claims 5 and 8, Hays discloses a single disc friction clutch comprising a clutch housing 12, a single clutch disc 14, a solid pressure plate 16, a friction lining 18 on the clutch disc, a membrane spring 30, and a thermal insulating member 44,56. The thermal insulating member is supported on the surface of the pressure plate between the pressure plate and the membrane spring, and is configured to minimize the contact between the thermal insulating member and the membrane spring (see column 6, lines 4-8). The thermal insulating member extends circumferentially about the pressure plate and has a first resistance to thermal conductivity. The membrane spring also inherently has a resistance to thermal conductivity. Since the thermal insulating member includes a molded plastic portion, it would have a higher resistance to thermal conductivity than that of the membrane spring. The thermal insulating

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member is rigid and comprises a metal, since the portion 44 is metal (column 6, lines 9-14). The metal of the insulating member is configured to minimize heat conduction from the pressure plate to the membrane spring (column 6, lines 4-8). With respect to claim 6, the insulating member of Hays includes a first surface contacting the membrane spring and a second surface contacting the pressure plate (see, for example, Figs. 2 and 3).

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Jarrett('874). Jarrett discloses a single-disc friction clutch comprising a clutch housing 2, a clutch disc 4, a pressure plate 3, and a membrane spring 5. The pressure plate has a first portion 3 to contact the clutch disc and a second portion 9 disposed away from the clutch disc. A thermal insulating member 11 is disposed between the membrane spring and the first portion of the pressure plate and is configured to minimize heat conduction from the pressure plate to the membrane spring. The second portion 9 of the pressure plate is disposed to contact the membrane spring.

Allowable Subject Matter

Claims 1-4 are allowed.

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FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

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application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney H. Bonck whose telephone number is (703) 308-2904. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor, can be reached on (703) 308-0830. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.


RODNEY H. BONCK
PRIMARY EXAMINER
ART UNIT 3681

rhb
October 20, 2000